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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,247	06/23/2000	Raanan Liebermann	00-422RE	9739

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EXAMINER

WOO, STELLA L

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 01/27/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/603,247

Applicant(s)

LIEBERMANN, RAANAN

Examiner

Stella L. Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-32, 46 is/are allowed.
- 6) ☒ Claim(s) 33-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION***Reissue Applications***

1. Claims 33-45 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. *See Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

During the original prosecution, the examiner issued an Office action, mailed October 1, 1997, rejecting independent claims 1, 12, and 26 based on the prior art references of Kurokawa, Rogers and Abramatic. In a response to the Office action, applicant amended independent claims 1, 12 and 26 by further defining the video apparatus as “visually observing the images of *facial* and hand and finger signing motions of a deaf person and converting the observed signing motions into digital identifiers,” further defining the means for translating as “translating said digital identifiers of said observed signing motions into words and phrases,” and further defining the means for outputting as “outputting said words and phrases generated by the visual observation of said signing motions in a comprehensible form to another person”

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(underlining shows added subject matter). The applicant stated that “[t]he independent claims have ...been amended to clarify the unique operation and structure of the present invention. More particularly, each of the independent claims clearly defines the first step of the method or one component of the apparatus as visually observing the *facial*, finger and hand motion of the deaf person and converting those signing motions into digital identifiers which are then translated into words and phrases.” The applicant specifically argued that “[b]ecause of the technology employed by Applicant in the novel method, the full range of signing motions can be observed, including hand motion, finger motion including interdigitation, body motion, lip motion and *facial motion*... None of the prior art can approach the apparatus and method of the present invention from the standpoint of recognition of all these forms of signing activity.” Therefore, the subject matter previously surrendered in the application for the patent is a system without the following limitations: a video apparatus for visually observing the images of *facial* and hand and finger signing motions and converting the observed signing motions into digital identifiers, a means for translating said digital identifiers of said observed signing motions into words and phrases, and a means for outputting said words and phrases generated by the visual observation of said signing motions.

The limitations omitted in the newly added claims 33-45 of the reissue are the same limitations added by the applicant for the purpose of obtaining allowance in the original prosecution, as clearly stated in applicant’s arguments during the original prosecution, and applicant is now precluded from recapturing subject matter previously surrendered. The applicant cannot acquire, through reissue, claims that are the same or broader in an aspect germane to a prior art rejection and narrower in another aspect unrelated to the rejection.

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Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 34, 37, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakiyama in view of Wycherley et al. (US 5,163,081, hereinafter "Wycherley").

Sakiyama differs from claims 34, 37 and 45 in that it does not specify the translating taking place at a location remote from either party or communication taking place over telephone lines.

However, as taught by Wycherley (note Fig. 1), it is well known to centralize the translation process (central station 200) in order to convert communications between an aurally normal person and a remotely located aurally impaired person over the telephone network. It would have been obvious to an artisan of ordinary skill to incorporate such remote communication and centralized translation, as taught by Wycherley, within the system of Sakiyama in order to allow communications between remote parties.

Allowable Subject Matter

4. Claims 1-32 and 46 are allowed because although claims 1-32 and 46 were broadened by deleting the “deaf” limitation, the claims 1-32 and 46 are broader in an aspect unrelated to a prior art rejection made in the original application. Claims 1-32 and 46 recite allowable subject matter because the prior art of record do not show or fairly suggest conversion of observed facial, hand and finger motions to digital identifiers which are then translated into words and phrases.

Response to Arguments

5. Applicant's arguments filed November 13, 2003 have been fully considered but they are not persuasive.

Regarding the rejection of claims 33-45 under 35 USC 251, Applicant argues that “[t]here was never a rejection of a claim directed to ... the device used by the hearing impaired person to view a textual display, also including means for receiving words from the hearing impaired person.” The examiner disagrees. Claim 7 of the original application further limits the means for outputting said visual form ...for viewing by the deaf person by specifying that “said outputting means converts said spoken words and phrases into written form.” This claim was rejected during prosecution of the original application in the Final Office action mailed June 24, 1998 as being unpatentable over Sakiyama et al. in view of Abe et al. in which Sakiyama et al. discloses a handicapped person side display unit 36 with monitor 7 which outputs the translated spoken words and phrases (see Figure 23 in which text is displayed to the handicapped user).

Regarding the rejection of claims 33, 35-36, 38, 40-44 as being anticipated by Sakiyama et al., Applicant argues that “the outputting means in Sakiyama et al. is the monitor which lacks any means for receiving words and phrases from the hearing impaired person.” However, claim

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33 recites “**said device** utilized by said hearing impaired person including means for receiving words and phrases from the hearing impaired person,” not the **outputting means**, as asserted by Applicant. The device utilized by the hearing impaired person in Sakiyama et al. includes a video camera 21 and sign language word recognition unit 23 which receives words and phrases from the hearing impaired person (col. 16, lines 25-28).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

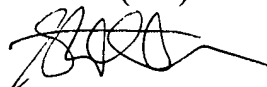
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella L. Woo whose telephone number is (703) 305-4395. The examiner can normally be reached on Monday-Tuesday, Thursday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (703) 305-4708. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.



Stella L. Woo
Primary Examiner
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